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| APPLICATION NO.        | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------|-------------|----------------------|---------------------|------------------|
| 09/018,104             | 02/03/1998  | JAMES L. HOBART      | PHAN-00100          | 9278             |
| 28960                  | 7590        | 05/14/2004           | EXAMINER            |                  |
| HAVERSTOCK & OWENS LLP |             |                      | SHAY, DAVID M       |                  |
| 162 NORTH WOLFE ROAD   |             |                      | ART UNIT            |                  |
| SUNNYVALE, CA 94086    |             |                      | PAPER NUMBER        |                  |

3739 43  
DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/018,104

Applicant(s)

Hobart

Examiner

d. shay

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE — 3 — MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on December 1, 2003
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-4, 6-14, 17-24, & 41-49 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-4, 6-14, 17-24, & 41-49 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 38, 42, 42a
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

The rejections under 35 U.S.C. 112, first paragraph, set forth in the previous office actions are hereby withdrawn in view of applicants amendments.

Regarding the rejection under 35 U.S.C. 102 set forth in the previous office action, applicant argues that Dwyer et al fail “to teach a laser source having multiple lasers, wherein pulses of the laser source are combined to generate a single laser output or a single operative condition such as coagulation or ablation when the system is in coagulation mode or ablation mode, respectively.” The remarks by applicant are noted, however these are not convincing. As already noted in a previous office action with regard to the teachings of Dwyer and the applicability thereof to claims 17 and 41, applicant’s attention is respectfully invited to Figure 3 of Dwyer et al and the attendant disclosure. Figure 3 shows two lasers (35 and 36) which are controlled by a wavelength selecting switch (38) and whose outputs are combined at beam splitter (37). This is stated at column 4, lines 12-22 of Dwyer et al. It is noted that the pulses produced by the lasers of Dwyer et al must have both a power and duration else they would not exist.

These are the structures required by claim 17. The claim does contain a functional statement regarding the function of the control system: “for controlling generation of the laser pulses...” The examiner first notes that this recitation is not of the proper form to invoke 35 USC 112; sixth paragraph (see MPEP 2181) thus the function is accorded little weight. Secondly, the functional recitation merely recites that the coagulation depth be controllable and since Dwyer et al teach that the “respective lasers are turned on and off as desired” (see column

4, lines 20 and 21) this is considered to provide the recited controllability, even assuming that the claim language in question were crafted to invoke the sixth paragraph of 35 U.S.C. 112.

Regarding claim 41, applicant's attention is once again invited to Figure 3 of Dwyer et al and lines 12-22 in column 4 thereof and the structures set forth above. Additionally optical fiber 21 constitutes a "means to direct." as recited in the claim. It is noted that the ability of the switch to provide pulses from alternating lasers renders it a "means to alternate between pulses of the first set of laser pulses and pulses of the second set of laser pulses" as claimed.

As set forth above, the pulses of the two lasers in Figure 3 of Dwyer et al are combined at beam splitter (37) and steered to a single output path, the optical fiber (21), from which the pulses of both lasers exist to treat the tissue. The combined pulses, generated by the source of Dwyer et al enable either coagulation or cutting at the desire of the surgeon. The examiner once again notes that applicant has chosen to make arguments without pointing to specific structure which is lacking in Dwyer et al that prevents the reference from reading on the claims. As set forth previously, such arguments are not persuasive in view of the specific structures laid out by the examiner which provide the functions which applicant alleges are absent from Dwyer et al.

With regard to the rejection under 35 U.S.C. 103, applicant makes reference to a previous characterization wherein applicant argues each reference singly with no regard to what the combined teachings would suggest to one having ordinary skill in the art. Applicant also argues, without any rationale other than the aforementioned piecemeal treatment of the applied

references that a prima facie case of obviousness has not been made. These characterizations are not convincing for the reasons set forth previously. As set forth above Dwyer et al teach beam combining and controllable coagulation. Since this the apparent basis upon which applicant argues the patentability of all the claims, all of applicants arguments are not convincing. It is noted that claim 5 does not appear in the amendment, as applicant has requested replacement of all prior versions of the claims, claim 5 will be treated as cancelled.

Claims 1, 11, 17 and 41 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dwyer et al.

Claims 1-3, 8, 41, 43, 44, and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dew ('969) in combination with Anderson et al, and Belkin et al. Dew ('969) teaches the use of a carbon dioxide laser operating at 10.6 microns as a cutting laser in a laser system comprised of multiple lasers and teaches that the power of a pulse determines the amount of heat deposited in the tissue and that the same type of laser can be used for cutting and coagulating. Belkin et al teach that the carbon dioxide lasers operating at 10.6 microns can be used to heat rather than cut tissue. Anderson et al teach the way parameters such as absorptivity, spot size, and pulse width interrelate to control the amount of energy absorbed by tissue. It would have been obvious to the artisan of ordinary skill to use a carbon dioxide laser to coagulate in the device of Dew ('969), since this laser can be configured to coagulate as taught by Belkin et al, and since this would render the device more versatile, at no extra cost; and to employ the particular laser parameters claimed since these provide no unexpected result, and are

within the scope of one having ordinary skill in the art as shown by Anderson et al; to employ an articulated arm with refocusing convex lenses since these are notorious in the art for transporting infrared radiation such as that from Carbon dioxide lasers, official notice of which has already taken; and to use a galvanometer to alternate the beams, since these are notorious for moving optical components official notice which has already been taken thus producing a device such as claimed.

Claims 1, 6, 7, 11-13, 17, 18, 41 and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar et al in combination with Dwyer et al. Sklar et al teach the use of a graphic user interface for use with multiple lasers and teach that it can be used with any type of laser for any type of surgery and that the depth of laser action can be input and displayed. Dwyer et al provide the teachings set forth above. It would have been obvious to the artisan of ordinary skill to employ the interface of Sklar et al in the device of Dwyer et al, since Dwyer et al provide no control interface for the device made up of two separate lasers or to employ the laser source of Dwyer et al in the system of Sklar et al, since Sklar et al provide no particular laser source, thus producing a device such as claimed.

Claims 4, 9, 10, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dew ('969) in combination with Anderson et al and Belkin et al as applied to claims 1-3, 8, 41, 43, 44, and 47-49 are above, and further in combination with Assa et al. Assa et al teach a scanning handpiece and the equivalence of carbon dioxide and Erbium YAG lasers. Thus it would have been obvious to the artisan or ordinary skill to employ and handpiece as taught by

Assa et al, since this allows more consistency of treatment and to employ an erbium laser, since these are equivalent to the carbon dioxide laser, thus producing a device such as claimed.

Claims 14 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dew ('969) in combination with Anderson et al and Belkin et al as applied to claims 1-3, 8, 41, 43, 44 and 47-49 above, and further in combination with Sklar et al. Sklar et al teach a user interface for a multi-laser system. It would have been obvious to the artisan of ordinary skill to employ the interface of Sklar et al, since no interface is taught and this would allow the surgical treatment to be preprogrammed, as taught by Sklar et al, thus producing a device such as claimed.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dew ('969) in combination with Anderson et al, Belkin et al, and Sklar et al as applied to claims 14 and 19-22 above, and further in combination with Assa et al. The teachings of Assa et al and the motivations for combination thereof are essentially those already iterated above. Thus it would have been obvious to the artisan of ordinary skill to combine these old and well known teachings to produce a device such as claimed.

Applicant's arguments filed December 1, 2003 have been fully considered but they are not persuasive as set forth above.

This is a Request for Continued Examination of applicant's earlier Application No. 09/018,104. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.

Shay/DI

April 19, 2004



**DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330**